

## **Remarks**

### **1. Summary of the office action**

In the office action mailed November 28, 2008, (i) the Examiner objected to the title of the invention, (ii) the Examiner rejected claims 56-67 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, (iii) the Examiner rejected claims 43-53, 55-65, and 67 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0109310 (Heaton), and (iv) the Examiner rejected claims 54 and 66 under 35 U.S.C. § 103(a) as being unpatentable over Heaton in view of U.S. Patent Application Publication No. 2004/0005919 (Walker).

### **2. Claim amendments and pending claims**

Applicant has amended claims 43-50, 55-60, 64, and 66, and added new claims 68 and 69. Claims 43-69 are presently pending. Of the pending claims, claims 43 and 56 are independent.

### **3. Response to the objection to the title of the invention**

The Examiner indicated that the title of the invention is not descriptive and that a new title, clearly indicative of the invention to which the claims are directed, is required. *See*, office action, page 2.

Applicant has changed the title to --A menu system and a method of operating a menu system to display data corresponding to casino games --. Applicant submits that this amendment to the specification overcomes the Examiner's objection to the title of the invention.

### **4. Response to the claims rejections under 35 U.S.C. § 101**

The Examiner rejected claims 56-67 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because these claims are method or process claims that do not transform

underlying subject matter to a different state or thing, nor are they tied to another statutory class (such as a particular machine). Of these claims, claim 56 is independent.

Applicant has amended claim 56 to clarify that a *categorization device* of a *menu system* categorizes the available casino games into a plurality of different selectable game categories, and to clarify that a *display device* of the *menu system* simultaneously displays (i) an identity of each one of the plurality of different game categories, (ii) at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, and (iii) additional game attributes of any selected one of the games in the selected game category. The functions of claim 56, as amended, are tied to a particular machine (i.e., the menu system, and in particular, the categorization device and the display device). Applicant submits that claim 56, as amended, recites statutory subject matter.

Additionally, claims 57-67 depend from claim 56 and necessarily include all of the elements of claim 56. Applicant submits that each of claims 57-67 recites statutory subject matter. Because claims 56-67 recite statutory subject matter, Applicant respectfully requests that the Examiner withdraw the rejection of claims 56-67 under 35 U.S.C. § 101.

#### **5. Response to the claim rejections under 35 U.S.C. §§ 102 and 103**

The Examiner rejected claims 43-53, 55-65 and 67 under 35 U.S.C. § 102(e) as being anticipated by Heaton, and the Examiner rejected claims 54 and 66 under 35 U.S.C. § 103(a) as being unpatentable over Heaton and Walker. Of these claims, claims 43 and 56 are independent.

Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicant submits that Heaton does not anticipate claims 43 and 56, as amended, because Heaton does not disclose or suggest each and every element recited in these claims.

At a minimum, Heaton does not disclose or suggest: (i) the *display device* that *displays* to the player, *simultaneously*: a) *an identity of each one of the plurality of different game categories*, b) at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, and c) additional game attributes of any selected one of the games in the selected game category, as recited in claim 43, and (ii) the *display device displaying* to the player, *simultaneously*, a) *an identity of each one of the plurality of different game categories*, b) at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, and c) additional game attributes of any selected one of the games in the selected game category, as recited in claim 56.

In rejecting claims 43 and 56, the Examiner argued that Heaton, paragraph 0073 and Figures 3 and 8, discloses that a display means displays to players, simultaneously, a) *an identity of each one of the plurality of different game categories*, b) at least one attribute of each game in any selected one of the plurality of different categories (name of the game), and c) additional game attributes of any selected one of the games in the selected game category. *See*, office action, page 3, emphasis added.

Figure 3 of Heaton illustrates, *inter alia*, a display 300 that includes a menu bar 302. According to Heaton, in some embodiments, menu bar 302 may be divided into games, options, or any *other suitable categories*. *See*, Heaton, paragraph 0045. As far as Applicant can tell, even if it is assumed, for the sake of argument, that this portion of paragraph 0045 discloses that

the menu bar 302 may be divided into a games category, an options category, or any other suitable categories, Heaton does not disclose or suggest that the options category and/or the other suitable categories include at least one game category. Therefore, although Heaton discloses displaying one games category, Applicant submits that Heaton does not disclose or suggest the *display device displaying* to the player, *simultaneously*, an identity of each one of the *plurality of different game categories*, as recited in various ways in claims 43 and 56.

Because Heaton does not disclose or suggest each and every element of claims 43 and 56, Heaton fails to anticipate claims 43 and 56, and thus claims 43 and 56 are allowable. Additionally, without conceding any assertions made by the Examiner regarding dependent claims 44-55 and 57-67, Applicant submits that claims 44-55 and 57-67 are allowable for at least the reason that they depend from one of allowable claims 43 and 56. And Applicant submits that new claims 68 and 69 are allowable for at least the reason that they depend from one of allowable claims 43 and 56.

## **6. Conclusion**

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 43-69 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

Date: February 13, 2009

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